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November 7, 2001

CONFIDENTIAL
Attorney Client Privileged

Preliminary Opinion



R. Warren Comstock
Chief Counsel - Intellectual Property
Robert Bosch Corporation
P. O. Box 4601
Carolstream, IL 60197-4601

Re: M&G 13862.1-US-AA

Dear Mr. Comstock:

I. Scope of the Project

I have been asked by you, on behalf of Robert Bosch Corporation, to give an opinion on whether or not the manufacture and sale by Vermont American Corporation and the sales by Sears and the use by its customers of the router table fence, known as the CRAFTSMAN® Professional Router Table Fence, would infringe any claim of U.S. Patent No. 5,779,407, owned by Lee Valley Tools, Ltd. of Ottawa, Canada.

II. Conclusions

It is my opinion that no valid claim of U.S. Patent No. 5,779,407 would be infringed by the manufacture, sale or use of the CRAFTSMAN® Professional Router Table Fence, described in more detail hereinafter. It is my opinion that claims 2, 3, 4, 6, 9, and 11-26 are not infringed either literally or under the doctrine of equivalents. It is my opinion that claims 1, 5, 7, 8, and 10 are invalid under 35 U.S.C. §102(b).

I am denominating this a preliminary opinion because I am in the process of having validity searches conducted in Japan; Europe and in the United States. The results of these searches will not change the opinions expressed herein, but they may support further reasons for invalidity. I know that timing is important for you; and therefore, I wanted to get this preliminary opinion to you as quickly as possible.

Minneapolis/St. Paul
Denver
Seattle
Atlanta

III. Preparation for Opinion

I have reviewed in detail U.S. Patent No. 5,779,407; its file history and relevant prior art. I have reviewed the opinion of Roger D. Greer of Greer, Burns & Crane, dated July 2, 2001, and the prior art referred to in that opinion. I have reviewed the letter of John S. Pratt of Kilpatrick Stockton, LLP, dated September 13, 2001 to Mr. Michael J. Burke of Sears, Roebuck & Co. I have reviewed certain prior art materials supplied to me from the file of Mr. Greer in which included the results of his prior search in the United States Patent and Trademark Office. I have reviewed a memorandum from Don Szymanski to Julia Hagan, dated January 16, 2001, describing the Y2K router table fence that became the CRAFTSMAN® professional router fence, which is the subject of this opinion. I have personally assembled a CRAFTSMAN® professional router fence, except for mounting the same to a router table and except for adding the extrusion endcaps. I have reviewed in detail the Sears owner's manual for the CRAFTSMAN® professional router table fence. I have reviewed in detail the CRAFTSMAN® professional router table fence as assembled by me and as described in the owner's manual. A router table fence of Jointech, Inc., Model SF-32, and bearing the trademark SMARTFENCE®, has been supplied to me. I have reviewed the structure of Jointech's SMARTFENCE® router table fence. I have reviewed an owner's manual for Jointech's SF-24 and SF-32 router table fence. I have reviewed the results of a trademark search with respect to Jointech's SMARTFENCE trademark. I have reviewed a publication attached as Exhibit 11 and a sample fence made as disclosed in the publication. I have reviewed Webster's International Dictionary with respect to the terms "spar"; "top"; "bottom"; "extrusion"; "depression"; and "substantially". I have reviewed the Manual of Patent Examining Procedure with respect to use of the term "comprising" in claims; and I have reviewed the case law cited in this opinion relating to infringement and validity. The above relates to most of my preparation for this opinion; however, I do not wish to be precluded from identifying other matters actually reviewed by me for this opinion even though not listed here.

IV. Basis for the Opinion

A. U.S. Patent No. 5,779,407

A copy of U.S. Patent 5,779,407 is attached as Exhibit 1. It issued on July 14, 1998 upon an application filed January 30, 1997. It claims the benefit of a U.S. provisional application, Serial No. 60/10,975, filed February 1, 1996. The effective filing date of the application resulting in the '407 patent is February 1, 1996.

The application was filed in the name of four inventors, all of Canada: Edwin C. Tucker; Michael S. McGuire; Leonard G. Lee; and John S. Lynn. The patent has been assigned to Lee Valley Tools Ltd. of Ottawa, Canada. A computer search has been made and the patent has not been further assigned; there has been no reissue or reexamination; and the patent has not been in litigation.

The application was filed with 27 claims. A requirement for restriction was made; and applicants elected claims 1-26. In a first action on the merits, Paper No. 7 mailed December 12, 1997, the examiner allowed claims 1-26; noted that claim 27 (erroneously denoted claim 7) was withdrawn from further consideration; and noted a description on page 6 of the specification which required clarification. Applicants amended the description at lines 10-14 of page 6 of the specification. The patent examiner, by an Examiner's Amendment, cancelled claim 27; and the application was allowed and passed to issue.

On June 13, 1996, applicants filed an IDS which cited a number of documents. The examiner indicated he had reviewed the other documents identified in the IDS by initialing the same. The examiner in his action, Paper No. 7, cited U.S. Patent Nos, 5,016,693; 5,325,900; 5,443,554; and 5,553,644.

As will be discussed hereinafter, applicants' IDS did not identify the Jointech fence as commercially sold and described in its owner's manual. It is not known whether applicants knew of such prior art; but in view of the materials which they did submit, it appears likely that they should have known of a commercial Jointech model SF-32 product.

Of the 26 claims of the '407 patent, claims 1, 24 and 26 are independent claims. Claims 2-23 are dependent at least upon claim 1 and claim 25 is dependent upon claim 24. Claims 1-25 are apparatus claims directed to a router table fence for use with a router table top. Claim 26 is a method claim for accurately positioning a router table fence on a router table top.

B. The CRAFTSMAN® Professional Router Table Fence

An owners manual of the CRAFTSMAN® professional router table fence under consideration is attached as Exhibit 2. Attached as Exhibit 3 are photos of the CRAFTSMAN® table fence, assembled by me. From Exhibits 2 and 3, the structure of the CRAFTSMAN® router table fence should be readily understood by a person of skill in the art. However, because of certain claims of the '407 patent, it is desirable to note some of the specific differences between the CRAFTSMAN® router table fence and the table fence of the '407 patent.

The CRAFTSMAN® router table fence as manufactured and sold does not comprise two sub-fences. The CRAFTSMAN® router table fence does not have top and bottom fence members in which the cross-sectional shape of each of the top and bottom fence members are substantially identical. In the CRAFTSMAN® router table fence, the cross-sectional shape of each of the top and bottom fence members are not substantially square. The CRAFTSMAN® router table fence does not have bottom fence members in which the bottom faces have a longitudinal T-slot therein. The CRAFTSMAN® router table fence has structure for fixing the fence to a router table top which is quite different from that disclosed in the '407 patent. More particularly, the CRAFTSMAN® router table fence does not have the clamping structure specifically defined in claim 14 of the '407 patent. The CRAFTSMAN® router table fence does not have a dust chute which includes a magnet affixed to the chute for attachment of the chute to ferrous metal surfaces. The CRAFTSMAN® router table fence does not have a safety shield which is attached to a vertical arm for fixation to the front of the fence; but rather, in the CRAFTSMAN® fence, the safety shield is attached to the dust chute at the rear of the fence. The CRAFTSMAN® fence does not have the hold-down assembly which is claimed in claim 18 of the '407 patent. The CRAFTSMAN® fence does not have a micro-adjust stop claimed in claim 20 of the '407 patent. The CRAFTSMAN® fence does not have a fixed stop as described in claim 23 of the '407 patent. Since the CRAFTSMAN® fence does not have the micro-adjust stop of the '407 patent, the CRAFTSMAN® router table fence would not use the method specifically described in claim 26 of the '407 patent.

C. General legal precepts applied

There are two types of infringement: literal infringement and infringement under the doctrine of equivalents.

A two-part analysis is used to determine whether literal infringement exists. The first step is determining the meaning and scope of the patent claim; and the second step is comparing the properly construed claim to the device or process under consideration. Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*), aff'd, 517 U.S. 370 (1996).

To prove literal infringement, the patentee must show that the accused device contains every limitation in the asserted claim. If even one limitation is missing or not met as claimed, there is no literal infringement. Mas-Hamilton Group v. LaGard, Inc., 156 F.3d 1206, 1211 (Fed. Cir. 1998).

Even if there is no literal infringement, one must consider whether or not there is infringement under the doctrine of equivalents. See Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 520 U.S. 17, 117 S. Ct. 1040 (1997). An accused product is considered to be equivalent to the claimed product or process if the differences between the claimed device or process and the accused device or process are "insubstantial." Sage Products v. Devon Industries, 126 F.3d 1420 (Fed. Cir. 1997). A classic test used to determine whether the differences are substantial or insubstantial is whether the elements of the accused product perform substantially the same function in substantially the same way to achieve substantially the same result as the claimed product. Sage Products, 126 F.3d at 1424. A limitation on the application of the doctrine of equivalents is the "all elements rule" which provides that there can be no infringement unless the accused product contains every element of the claimed product or its substantial equivalent. Corning Glassworks v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1259 (Fed. Cir. 1989). Hence, if an element of the claim is completely missing from the accused product, there can be no infringement, either literally or under the doctrine of equivalents.

The doctrine of equivalents is also limited by prosecution history estoppel, Warner-Jenkinson Co. Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 117 S. Ct. 1040 at 1049-50 (1997). In the Federal Circuit's recent *en banc* decision in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558 (Fed. Cir. 2000), it was held that prosecution history estoppel acts as a complete bar against any application of the doctrine of equivalents as to a claim element amended for reasons of patentability. Id. at 569. This decision, however, is not yet final.

If an independent claim is not infringed, then claims dependent upon such independent claim are not infringed for the same reason. Dependent claims contain further limitations and, therefore, may contain further reasons for no infringement.

35 U.S.C. §112(6) provides:

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claims shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

It is a patentee's burden to prove infringement by preponderance of the evidence. If a patent claim is asserted to be invalid, such claim carries a rebuttable presumption of validity, 35 U.S.C. § 282. Any assertion of the invalidity of a claim must be proven by clear and convincing evidence.

D. Opinions on Infringement

1. Claim 1 of the '407 Patent.

1. A router table fence for use with a router table top, comprising:
 - (a) a top spar having a first length and a front face.
 - (b) two bottom spars having front faces, and
 - (c) connectors for attaching the bottom spars to the top spar so that:
 - (i) the front faces of each of the top spar and the two bottom spars are in substantially the same plane and
 - (ii) opposed ends of the two bottom spars may be positioned either:
 - (x) abutting, or
 - (y) separated by a selected distance.

2. Construction of Terms Used in the Claims

a. Spar

The term "spar" is defined in Webster's Third New International Dictionary (1981) as a pole or moderately thick piece of timber; a stout rounded typically solid piece of wood or metal (as a mast, gaff, boom, etc.) used to support rigging; one of the main longitudinal members of the wing of an airplane.

These definitions do not appear to be particularly applicable. A patentee can be his own lexicographer; and the patent at column 2, line 7 equates the term "spars" with the term "extrusions". Also, the abstract at line 1 states in part: "a router table fence having three nesting aluminum extrusions or spars...". Therefore, I interpret the term "spar" as used in the claims to mean an extrusion.¹

b. Extrusion

An extrusion is "an article or product made by the process of extruding," Webster's Third New International Dictionary (1981). The process of extruding means to shape a material, such as aluminum, by forcing it through a die usually with either the material and/or the die being heated. See Webster's Dictionary (1981).

c. Top

"Top" means the highest point, level or part of something; the upper end or extremity; summit, crown. "Top" as an adjective means of, relating to or at the top; highest; topmost; uppermost. Webster's Third New International Dictionary (1981).

d. Top Spar

In view of the above definitions, I define "top spar" as meaning an extrusion which forms the highest point, level or part of the router fence claimed.

¹ Applicant's use of the term "spar" rather than the term "extrusion" implies to me that applicant may have intended "spar" to mean something broader than "extrusion", such as a longitudinally extending beam or fence member. Nevertheless, I have adopted the more restricted clear meaning of "spar" from the specification.

e. Bottom

"Bottom" means "the undersurface as opposed to the top surface." It means "of, relating to, or situated at a lower or lowest position." Webster's Third New International Dictionary (1981).

f. Bottom Spar

In my opinion, "bottom spars" are those extrusions which are situated or lie below the topmost or uppermost part of the top spar in view of the above definitions of "spar", "top", and "bottom".

g. Depression

Another term that may need a definition is the term "depression" as used in claim 7.

According to Webster's Third New International Dictionary (1981) a depression is "a part that is depressed, that is, displaced downward or inward or in a state of being displaced downward"; for example "a hollow".

h. Substantially

The term "substantially" is ubiquitous in patent claims. The term "gives some definitional leeway and avoids undue limits to the word that substantially modifies." See Landas on Mechanics of Patent Claim Drafting, 4th Edition, Paragraph 26A, Footnote 24. See also, Chisum 5A at Paragraph 18.07(2), Footnote 7. Basically, it means "largely, but not wholly that which is specified." In some cases, one must refer to the patent specification in order to determine if a specific definitional leeway is intended.

i. Substantially Rectangular

There is no guidance in the specification of the '407 patent which provides definitional limits on the term "substantially rectangular"; and the term is not specifically defined in the specification. Therefore, I interpret the term "substantially rectangular" in its normal dictionary definition to mean that the cross-sectional shape of the spars is not required to be specifically a rectangle or rectangular shape; but rather the spars at issue are in the main or to a large degree generally rectangular in shape.

j. Comprising

The transitional term "comprising" is inclusive or open-ended and does not exclude additional, unrecited elements. See paragraph 2111.03 Manual of Patent Examining Procedure, February 2000 at page 2100-38.

2. Interpretation of Claim 1

Claim 1

1. A router table fence for use with a router table top, comprising:
- (a) a top spar having a first length and a front face.
 - (b) two bottom spars having front faces, and
 - (c) connectors for attaching the bottom spars to the top spar so that:
 - (i) the front faces of each of the top spar and the two bottom spars are in substantially the same plane and
 - (ii) opposed ends of the two bottom spars may be positioned either:
 - (x) abutting, or
 - (y) separated by a selected distance.

Interpretation of Claim 1

Using the above definitions, it is my opinion that claim 1 may be interpreted to cover a router table fence for use with a router table top which includes at least the following elements:

- (a) An extrusion or extrusion portion having a first length and a front face in which at least the portion of the extrusion is at the top of the fence;
- (b) Two extrusions having front faces which are positioned below the top spar; and
Connectors for attaching the bottom spars to the top spar so that:
 - (i) The front faces of each of the top spar and the two bottom spars are in substantially the same plane and
 - (ii) Opposed ends of the two bottom spars may be positioned either:
 - (x) abutting, or
 - (y) separated by a selected distance.

My interpretation of other claims will become apparent in my discussion of the reasons for non-infringement and/or invalidity.

3. Opinions of Non-infringement

It is my opinion that claims 2, 3, 4, 6, 9, and 11-26 are not infringed either literally or under the doctrine of equivalents.

4. Literal Infringement

The above-identified claims are not literally infringed for the following reasons.

a. Claims 2, 3, and 9

With respect to claim 2 (and claims 3 and 9, which depend from claim 2), the CRAFTSMAN® router table fence does not have "two sub fences." Therefore, these claims would not be literally infringed for that reason.

b. Claims 4 and 6

Claims 4, and 6 relate to the specific form of the cross-sectional shape of each of the top and bottom spars. Claim 4 provides that the shape of each of the top and bottom spars is "substantially identical"; and claim 6 provides that the cross-sectional shape of each of the top and bottom spars is "substantially a square". The CRAFTSMAN® router table fence does not have these specific cross-sections as claimed. In the CRAFTSMAN® fence, the top spar is substantially square and the bottom spar is substantially rectangular but not square. Therefore, claims 4 and 6 are not literally infringed.

c. Claim 11

Claim 11 requires that "each of the top spar front and top faces and the bottom spar front and bottom faces have a longitudinal T-slot therein." In the CRAFTSMAN® router fence, the bottom faces of the bottom fence members do not have a longitudinal T-slot therein. Claim 11 would not be literally infringed for this reason.

d. Claim 12

Referring to Claim 12, it is dependent upon claim 1 and further comprises "means for fixing the fence to a router tabletop". This is a means plus function element governed by 35 U.S.C. § 112 (6). The means for fixing the fence to a router tabletop described in the specification are two clamps, one adjacent each end of the fence. Each clamp body has a projection with a T-shaped cross-section which is received in the T-shaped slot in the bottom of a bottom spar. A foot of the clamp protrudes under the router tabletop through which a threaded rod extends to exert pressure against the underside of the router tabletop. The rod has a handle attached to it for ease of rotating the rod.

The structure of the CRAFTSMAN® router table for attaching the fence to the table is substantially different from the clamps of the '407 patent. The CRAFTSMAN® router fence is attached to the router table by a pair of L-shaped mounting brackets which are secured in a slot at the back side of the upper fence member by bolts through the upper end of the vertically disposed leg of each bracket. The horizontal portion of each bracket is secured to the table top through a fence guide if the router table has V-grooves. If the router table does not have V-shaped grooves but instead has suitably positioned bolt holes for attaching a bracket, the bracket is mounted in this way. In my opinion, a person of skill in the art would believe the means for fixing the fence to a router table in the prior art Jointech router fence, described in more detail hereinafter, is closer to that of the '407 patent clamps than the CRAFTSMAN® means for mounting is to the '407 patent clamps. Therefore, it is my opinion that the means for mounting the CRAFTSMAN® fence to a router table is substantially different and not the equivalent of the means described in the specification of the '407 patent. Therefore, there is no literal infringement of claim 12.

e. Claim 13

Claim 13 is dependent upon claim 12 and further describes the "fixing means" as comprising "at least one clamp." The CRAFTSMAN® means for fixing the fence to the router table does not comprise a clamp. Claim 13 is not literally infringed for the same reason that claim 12 is not infringed but also because the means for fixing does not comprise a clamp.

f. Claim 14

Claim 14 is dependent upon claim 12 and it further recites that the "fixing means comprises two clamps" and describes the clamps in detail. Such clamps, as discussed with respect to claim 12, are not used in the CRAFTSMAN® fence. Therefore claim 14 is not literally infringed for this additional reason.

g. Claim 15

Claim 15 is dependent upon claim 1 and further comprises a "dust chute" which has "at least one magnet affixed to the chute for attachment of the chute to ferrous metal surfaces." The CRAFTSMAN® router table fence does not have a dust chute which includes such a magnet. In the CRAFTSMAN® fence, the dust chute is bolted to the back of the top spar. Therefore claim 15 is not literally infringed.

h. Claim 16

Referring to claim 16, it is dependent upon claim 1 and further comprises a "safety shield" in which the shield member is "attached to a vertical arm for fixation to the front of the fence." Unlike the safety shield of the '407 patent, the CRAFTSMAN® shield is attached to the dust chute at the back of the fence. Therefore claim 16 is not literally infringed.

i. Claim 17

Referring to claim 17, it is described as being dependent upon claim 1; however there is no antecedent for the safety shield of claim 17 in claim 1. I believe this to be a typographical error and that claim 17 must be dependent upon claim 16. Claim 17 would, therefore, not be literally infringed for the same reason that claim 16 is not infringed.

j. Claims 18 and 19

Claim 18 is dependent upon claim 1 and further adds the "hold-down assembly" 120 depicted in Fig. 9 of the '407 patent. The CRAFTSMAN® fence does not have a hold-down assembly required by claim 18 and, therefore, claim 18 is not literally infringed.

Claim 19 is dependent upon claim 18 and would not be infringed for the same reason claim 18 is not infringed.

k. Claims 20, 21 and 22

Claim 20 is dependent upon claim 1 and further comprises a "micro-adjust stop for accurately repositioning one end of the fence." The CRAFTSMAN® fence does not have a micro-adjust stop and, therefore, claim 20 is not literally infringed.

Claims 21 and 22 are dependent upon claim 20 and would not be infringed for the same reason claim 20 is not infringed. In addition, these claims further define detail of the micro-adjust stop, which is not a part of the CRAFTSMAN® fence.

l. Claim 23

Claim 23 is dependent upon claim 1 and further comprises a "fixed stop useable to establish the position of the fence on the router table to make it possible to remove the fence from the router table top and later return it to the same position." The CRAFTSMAN® fence does not have such a fixed stop and, therefore, claim 23 would not be literally infringed.

m. Claim 24

Claim 24 is an independent claim in which "each of [the two bottom] spars" have "a generally square cross-sectional shape with a laterally centered longitudinal T-shaped slot in each face." The lower fence members of the CRAFTSMAN® fence are rectangular and, therefore, they do not have a generally square cross-sectional shape; and the CRAFTSMAN® fence does not have a T-shaped slot in the bottom face of the lower fence members. Therefore, claim 24 is not literally infringed.

n. Claim 25

Claim 25 is dependent upon claim 24 and would not be infringed for the same reason that claim 24 is not infringed. In addition, claim 25 calls for a first structure which "comprise a pair of longitudinal ribs" and the second structure "comprises a pair of longitudinal ribs in a position laterally offset from the first pair of ribs." The CRAFTSMAN® fence does not have such pairs of longitudinal ribs and, therefore, does not literally infringe claim 25 for this additional reason.

o. Claim 26

Claim 26 is a "method claim for accurately positioning a router table fence on a router table top" which in steps (c)-(f) describes "positioning a micro-adjust fence stop" and using this to accurately position one end of the fence. The CRAFTSMAN® router fence has no "microadjust fence stop" and the steps (c)-(f) of claim 26 and form no part of positioning the CRAFTSMAN® router fence on a router tabletop. Therefore claim 26 is not literally infringed.

5. Consideration of the Doctrine of Equivalents

As mentioned, even if there is no literal infringement, one must consider whether or not there is infringement under the doctrine of equivalents. A limitation on the application of the doctrine of equivalents is the "all elements rule", which provides that there can be no infringement unless the accused product contains every element of the claimed product or its substantial equivalent.

Most of the claims discussed above with respect to literal infringement are also not infringed under the doctrine of equivalents because of a specific claimed element missing from the CRAFTSMAN® router fence.

a. Claims 2, 3, and 9

Claims 2, 3 and 9 reciting "sub fences" are not infringed under the doctrine of equivalents because the CRAFTSMAN® router fence does not have this element or its equivalent.

b. Claims 4 and 6

With respect to claims 4 and 6 the element added by these dependent claims is the specific cross-sectional shape of each of the top and bottom spars. The specific shape added by these dependent claims is not present in the CRAFTSMAN® router fence. Because the claims are directed to specific cross-sectional shapes, a structure which does not have the claimed shape is substantially different. Compare, for example, dependent claim 5. For these reasons, in my opinion, claims 4 and 6 of the '407 patent are not infringed under the doctrine of equivalents.

c. Claims 11, 12, 13, and 14

Claims 11, 12, 13 and 14 have been discussed in detail with respect to literal infringement. As previously stated, the structure for mounting the CRAFTSMAN® router fence to the router table is substantially different from that described and claimed in the '407 patent. For this reason alone, there would be no infringement under the doctrine of equivalents; but in addition claims 11-14 call for elements which are not present in the CRAFTSMAN® router fence. More specifically, neither the clamp elements and associated structure nor equivalents thereof are used in the CRAFTSMAN® router fence. In my opinion, claims 11-14 are not infringed under the doctrine of equivalents.

d. Claim 15

Referring to claim 15, element (c) thereof is a magnet affixed to the chute for attachment of the chute to ferrous metal surfaces. The CRAFTSMAN® router fence does not have this element or its equivalent; and therefore, claim 15 would not be infringed under the doctrine of equivalents.

e. Claims 16 and 17

Referring to claim 16, an element of the claim calls for the shield member to be attached to a vertical arm for fixation to the front of the fence. The CRAFTSMAN® router fence does not have this element because its shield is not attached for fixation to the front of the fence but rather is attached to the dust chute at the back of the fence. The shield of claim 16 is fixedly attached to the front of the fence. This makes for a much smaller shield. This may be an advantage in size, however, the fixed shield of claim 16, does not have the ability of the CRAFTSMAN® shield to pivot into and out of position. In my opinion these differences would be considered substantial by a person of skill in the art; and, in my opinion, claim 16 is not infringed under the doctrine of equivalents.

Claim 17 is not infringed under the doctrine of equivalents for the same reason that claim 16 is not infringed.

f. Claims 18, 19, 20, 21, 22, and 23

Claims 18, 19, 20, 21, 22 and 23 are each not infringed under the doctrine of equivalents because of elements specifically claimed which are not a part of the CRAFTSMAN® router fence. Claims 18 and 19 require a hold-down assembly; claims 20-22 require a micro-adjust stop; and claim 23 requires a fixed stop. The CRAFTSMAN® router fence does not have these elements or equivalents thereof.

g. Claims 24 and 25

Claim 24, among other limitations, requires a longitudinal T-shaped slot in the bottom face of each of the two bottom spars. As noted, the CRAFTSMAN® router fence does not have such a T-shaped slot. The T-shaped slot in the bottom face of the bottom spars is important in the patented construction because of its use in clamping the fence to a router table. Other than using the T-shaped slot in the bottom of the two bottom spars, there is no other structure described for mounting the '407 patented fence to a router table top. This slot or its equivalent is not present in the CRAFTSMAN® router fence. Therefore, under the all elements rule, there is no infringement of claim 24 under the doctrine of equivalents.

Claim 25 is dependent upon claim 24; and it would not be infringed under the doctrine of equivalents for at least the same reasons expressed with respect to claim 24.

h. Claim 26

With respect to claim 26, because the CRAFTSMAN® router fence does not have the recited "micro-adjust fence stop" there are several steps of the method or process which are not present in the CRAFTSMAN® router fence and its attachment to a router table. More specifically, steps (c)-(f); and therefore, under the all elements rule, claim 26 would not be infringed under the doctrine of equivalents.

6. Conclusions on Infringement

In conclusion, it is my opinion that claims 2, 3, 4, 6, 9, and 11-26 of U.S. Patent No. 5,779,407 are not infringed either literally or under the doctrine of equivalents by the manufacture, sale or use of the CRAFTSMAN® router fence previously described in detail.

E. Opinion on Validity

It is my opinion that claims 1, 5, 7, 8 and 10 are invalid as being anticipated under 35 U.S.C. §102(b) because the invention of these claims was in public use or on sale in this country, more than one year prior to the date of the application, which resulted in the '407 patent.

1. Jointech's Model SF-32 Router Fence is Prior Art

The particular anticipating router fence upon which I rely, is the fence manufactured and sold by Jointech, Inc. under the trademark SMARTFENCE®, the structure of which is shown in the attached photos marked Exhibit 4. Attached as Exhibit 5 is an owner's manual for the SF-32 router fence; and attached as Exhibit 6 is a copy of a parts list and instructions for the mounting brackets for the Jointech router fence.

Both Exhibits 5 and 6 bear the copyright notice © 1994. Jointech's application for trademark registration of the mark SMARTFENCE® states a first use in commerce of July, 1994. Attached as Exhibit 7 is a copy of page 123 of Tauton's "Fine Woodworking" of October 1994. See also Exhibit 8. A reprint from the American Woodwork Magazine, August 1995 issue, Exhibit 9, identifies the editor's choice award going to Jointech's SMARTFENCE® SF-32.

From all of the above facts, it is my opinion that Jointech, Inc.'s SF-32 router fence was on sale and in public use before February 1, 1995. Mr. Pratt in his letter to Mr. Burke of September 13, 2001 comments on U.S. Patent No. 5,553,644 as prior art; but he does not contend that U.S. Patent No. 5,553,644 is not prior art. I assume therefore that the filing date of the '644 patent,

June 8, 1995 is probably prior to the invention of the '407 patent which occurred some time prior to February 1, 1996.

For all of the above reasons, there is prima facie clear and convincing evidence that the Jointech router fence Model SF-32 was on sale and in public use more than one year before the filing date of the application resulting in the '407 patent or was on sale or in public use before the invention of the '407 patent.

2. Structure of Jointech's SMARTFENCE® Router Fence

The Jointech router table fence is for use with a router tabletop and it comprises three spars or extruded aluminum fence members. The structure of the SF-32 router fence is described in part in U.S. Patent No. 5,553,644, attached as Exhibit 10, which was filed on June 8, 1995.

I am not relying on the '644 patent as anticipatory prior art because it discloses and describes a router fence which has a top spar 11; two bottom spars 20 and 30 and a central fence member or insert 40. As disclosed in the '644 patent, insert 40 would prevent the spars 20 and 30 of '644 from abutting. With the exception of the disclosure of the insert 40, the drawings of the '644 patent and the description of the structure can be useful in identifying the parts of the commercial Jointech SMARTFENCE® product. First, it should be particularly noted that, unlike the disclosure of the '644 patent, the owner's manual for the SF-32 specifically states at page 8 of Exhibit 5 that the "Profile inserts do NOT have to be used." Indeed, the instructions point out that the inserts cannot be used for jointing or shaping operations whenever the fences are offset. The option not to use insert 40 and the requirement that it cannot be used for jointing or shaping operations whenever the fences are offset is not disclosed in the '644 patent; and therefore, this information was not available to the Patent Examiner in acting upon the application resulting in the '407 patent. The fact that the inserts cannot be used whenever the fences are offset is not as important as the disclosure of the owner's manual that the profile inserts do NOT have to be used. When the fences are offset, the front faces of the top spar and the two bottom spars would not be in substantially the same plane as required by the claims of the '407 patent. However, when the inserts are not used, and the fences are not offset, Jointech's SF-32 router fence fully anticipates the claims previously designated as being invalid. See photos Exhibit 4.

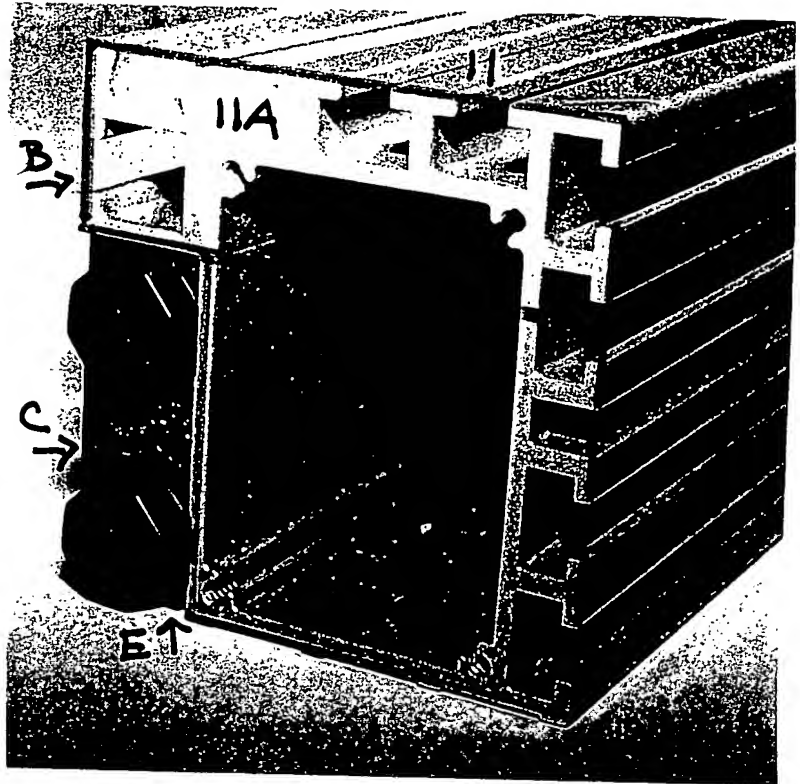
a. Claim 1 is invalid.

Within the definition of top spar previously given, Jointech's router fence has a top spar indicated by the numeral 11 in the '644 patent (Exhibit 10). Within the definition of bottom spar previously given, Jointech's commercial router fence has two bottom spars indicated by the numerals 20 and 30 in the '644 patent (Exhibit 10). The bottom spars 20 and 30 are connected to the top spar 11 by a plurality of bolts 24 having enlarged head portions 24a which traverse the tubular body element 11 as shown in fig. 3a of the '644 patent. The enlarged head portions 24a of the bolts 24 engage in an elongated T-slot 26 which traverses the entire length of the fence elements 20 and 30. As mentioned, when insert 40 is not used, and when the adjusting rods 27 and 28 are positioned in the zero adjustment, the front faces of each of the top spar and the two bottom spars are in substantially the same plane (see Figure 3a of the '644 patent, Exhibit 10) and opposed ends of the two bottom spars may be positioned either abutting or separated by a selected distance. See photos at Exhibit 4. The bottom spars may be locked into their adjusted position by tightening bolts 24 by rotating knobs 24c.

Claim 1

Prior art SF-32 Jointech Fence

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A router table fence for use with a router table top, comprising

(a) A top spar having a first length and a front face

(b) Two bottom spars having front faces

(c) Connectors for attaching the bottom spars to the top spar so that:

(i) the front faces of each of the top spar and the two bottom spars are in substantially the same plane, and

It is a router table fence for use with a router table top,

(a) Top spar may be either the entire extrusion 11 as depicted in '644, Ex. 10 or an extrusion portion outlined in orange above and marked 11A having a front face B,²

(b) Bottom spars 20 and 30 as depicted in '644, Ex. 10 have front faces, see C above,

(c) If top spar is entire extrusion 11 then connectors are bolts 24 as indicated in '644, Ex. 10. If top spar is extrusion 11A then connectors include bolts 24 and extrusion portion 11B outlined in green above.

(i) Face B of top spar and faces C of bottom spars 20 and 30 are in the same vertical plane,

² There are alternative ways to read element (a) of claim 1 on the Jointech fence.

(ii) opposed ends of the two bottom spars may be positioned either:

(x) abutting, or

(y) separated by a selected distance.

(ii) opposed ends D (see photos Ex. 4) may be positioned either:

(x) abutting, (see second page of photos, Ex. 4), or

(y) separated by a selected distance (see Ex. 4, front view showing bottom spars spaced).

Claim 1 of '407 is anticipated under 35 U.S.C. §102(b).

b. Claim 5

5. The router table fence of claim 1, wherein the cross-sectional shape of each of the top and bottom spars is substantially a rectangle.

From Fig. 3a of '644, Ex. 10, and the photo above of the prior art Jointech fence, it is clear that the cross-sectional shape of each bottom spar is a rectangle. If the top spar is the entire extrusion 11 (see claim 1 analysis above), the cross-sectional shape of top spar 11 is substantially rectangular. See definitions of "substantially" and "substantially rectangular" at page 5, supra. U.S. Patent 5,553,644, Ex. 10, describes at Column 4, lines 7-8 that elongated tubular body 11 formed of metal or rigid plastic is of "generally rectangular configuration..."

If the top spar is extrusion portion 11A, see photo above, the cross-sectional shape of the top spar is rectangular.

Claim 5 of '407 is anticipated under 35 U.S.C. §102(b).

c. Claim 10

10. The router table fence of claim 1, wherein the top spar has a top face orthogonal to the front face, the front faces of the bottom spars are in substantially the same plane as the top spar front face and the bottom spars each have a bottom face substantially orthogonal to the bottom spar front faces.

The top spar 11 (or 11A) of the Jointech fence has a top face orthogonal (at right angles) to the front face B, the front faces C of the bottom spars 20 and 30 are in substantially the same plane as top spar front face B and the bottom spars each have a bottom face E (see photo above) substantially orthogonal (at right angles) to the bottom spar front faces C.

Claim 10 is anticipated under 35 U.S.C. §102(b).

d. Claim 7

7. The router table fence of claim 1, wherein one of the top spar or the bottom spars has at least one rib that may be received in a depression in the other of the bottom spars or the top spar so that the bottom spars may slide longitudinally relative to the top spar while the bottom spars maintain vertical alignment relative to the top spar and each other.

Spar 11 of Jointech's prior art fence product has ribs 11K as depicted in '644, Ex. 10, which project into a depression or hollow in fence members 20 and 30 and engage in a depression in adjusting rods 27 and 28 carried by each of fence members 20 and 30 when the angular adjustment is at zero, see Fig. 3a of '644, Ex. 10.

Therefore, the prior art Jointech fence has a top spar 11 with at least one rib 11K that may be received in a depression in the bottom spars so that the bottom spars may slide longitudinally relative to the top spar while the bottom spars maintain vertical alignment relative to the top spar and each other.

Claim 7 is anticipated under 35 U.S.C. §102(b).

e. Claim 8

8. The router table fence of claim 1, further comprising means for engaging the bottom spars with the top spar so that the bottom spars may slide longitudinally relative to the top spar while maintaining vertical alignment relative to each other.

Claim 8 requires separate attention because it includes a means plus function element which is governed by 35 U.S.C. § 112(6). Claim 8 calls for the router table fence of claim 1 to further comprise "means for engaging the bottom spars with the top spar so that the bottom spars may slide longitudinally relative to the top spar while maintaining vertical alignment relative to each other". Specifically the specification of '407 discloses that each of the lower spars 22 and 24 have upstanding ribs 34 which are received in longitudinal slots or depressions 36 in the bottom of upper spar 20; in addition, the means for engaging the top spar and the bottom spar includes screws 38 having a long rod-shaped head connecting the upper spar 20 to lower spars 22 and 24 by passing through spar 20 and into nuts 39 located in the upper T-slots 32 in spars 22 and 24. Claim 8 is broad enough under §112(6), (which includes equivalents) that the ribs may be carried by either the top spar or bottom spars.

In Jointech's prior art fence, the "means for engaging the bottom spars with the top spar so that the bottom spars may slide longitudinally relative to the top spar while maintaining vertical alignment relative to each other includes a pair of ribs 11K carried by top spar 11 which are received in longitudinal slots or depressions, as described above with respect to claim 7; and the means for engaging further includes bolts 24 having an enlarged portion 24a comparable to the screws 38 of '407. Bolts 24 can be tightened to firmly secure the bottom spars in relation to the top spar in the same manner as bolts 38 of the '407 patent.

Claim 8 is anticipated under 35 U.S.C §102(b)

Conclusion

There is no language recited in claims 1, 5, 7, 8 and 10 of the '407 patent which is capable of being distinguished from Jointech's prior art router fence structure. Therefore, claims 1, 5, 7, 8 and 10 of the '407 patent are invalid under 35 USC §102(b) as anticipated by Jointech, Inc.'s commercial router table fence Model SF-32.

3. Comments on Mr. Pratt's letter to Mr. Burke of September 13, 2001.

Mr. Pratt criticizes Mr. Greer for relying upon prior art which was before the Examiner, namely the Adams '644 patent. While the Adams patent was before the Examiner, the different structure of the commercial Jointech router fence was not before the Examiner.

Mr. Pratt primarily distinguishes the disclosure of the '644 patent on three grounds.

First, Mr. Pratt notes that patent claim 24 requires that the bottom spars have a T-shaped slot in each face and he notes that the structure of the '644 patent does not have such a slot. It is my opinion that claim 24 would not be infringed for the very reason that the bottom spars of the CRAFTSMAN® router fence do not have a T-shaped slot in the bottom face. Whether claim 24 is anticipated by Jointech is not at issue because it is not infringed.

Second, Mr. Pratt comments that claim 1 of the '407 patent requires that the bottom spars may be positioned so that their opposed ends abut. He notes that elements 20 and 30 of '644, even assuming they are "bottom spars", do not abut each other; there is no suggestion that they be abutted; and they appear to be incapable of abutting. Mr. Pratt further states that an insert fence element 40 is positioned between elements 20, 30, thereby preventing abutment. Although the statements of Mr. Pratt may be true with respect to the disclosure of the Adams, '644 patent, the statements are not true with respect to the commercial Jointech product upon which I rely for my opinion. In the Jointech commercial product, the bottom spars may abut; they are capable of abutting; and there is no fence element 40 required to be positioned between elements 20, 30, thereby preventing abutment.

Finally, Mr. Pratt argues that the bottom fence elements 20 and 30 are positioned beside and not below the tubular body 11. Mr. Pratt ignores the fact that fence elements 20 and 30 of the Jointech router fence are positioned both beside and below tubular body 11. Mr. Pratt is looking at only part of the tubular body 11 and not the structure as a whole. He ignores extrusion portion 11A.

4. Additional Prior Art.

As mentioned, a further search is being conducted and has not been completed. However, an additional piece of pertinent prior art is the router table disclosed in Exhibit 11, published in a Shopnotes magazine No. 1 in 1992. The fence members in this disclosure are not extrusions; but it clearly suggests structure anticipating the broad claims of the '407 patent. This article was also not before the Patent Examiner. A prototype sample of the fence described in Exhibit 11 has been made and photos of it are attached as Exhibit 12. In my opinion, Exhibits 11 and 12 disclose a router fence which is better prior art than that before the Examiner.

V. Conclusion

It is my opinion that claims 1, 5, 7, 8, and 10 of U.S. Patent No. 5,779,407 are invalid and that the CRAFTSMAN® Professional Route Table Fence does not infringe any of claims 2-4, 6, 9, and 11-26.

There may be additional reasons for non-infringement and/or invalidity than those specifically stated. The reasons given are sufficient for my conclusions; however, I do not wish to be precluded in any way from having additional reasons upon further consideration or upon obtaining further information with respect to this matter.

R. Warren Comstock
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November 7, 2001

After you have reviewed this report, if you have any questions or if you wish further information, please do not hesitate to let me know. As indicated, this is a preliminary report and I will be following-up upon receiving the results of my searches.

Yours very truly,

MERCHANT & GOULD P.C.


John D. Gould

JDG/js/njo

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